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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/550,499	04/14/2000	G. Victor Guyan	7752.0016-00	9245

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EXAMINER

VAUGHN, GREGORY J

ART UNIT	PAPER NUMBER
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2178

DATE MAILED: 10/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/550,499

Applicant(s)

GUYAN ET AL.

Examiner

Gregory J. Vaughn

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 April 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. This action is responsive to the application filing, Application filed on 4/14/2000.
2. Claims 1-21 are pending in the case, claims 1, 9 and 13 are independent claims.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

*"(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made."*

4. Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nolan et al., US Patent 5,253,362 (filed 1/29/1990, patented 10/12/1993) in view of Borghesi et al., US Patent 5,950,169 (filed 11/9/1995, patented 9/7/1999). "*Nolan et al.*" is hereafter referred to as "*Nolan*". "*Borghesi et al.*" is hereafter referred to as "*Borghesi*".
5. In regard to independent claim 1, the claim recites "*A method for generating a file note for an insurance claim, comprising the steps, executed in a data processing system, of: prefilling a first set of fields with information identifying a file note; obtaining a selection of fields from a user for a second set of fields; permitting the user to add data to a predefined text area based on the selected fields; and*

*generating a file note that contains the first set of fields, the second set of fields, and the data in the predefined text area."* Nolan discloses the prefilling of data by the system. Nolan recites *"In FIG. 4, a nursing annotation window 480 is illustrated. Window 480 provides a parameter title 481, date 482, time 483"* (column 5, lines 20-22). Nolan discloses a user selecting additional fields for data entry. Nolan recites *"Additionally, when an annotation is to be entered, such as in FIG. 6, a window 498 may be displayed. Window 498 provides a list of predefined, commonly used annotations"* (column 5, lines 51-54). Nolan discloses a user adding data to the predefined text area. Nolan recites *"Next, in decision step 203, if a standard option is selected from the standard annotation options, process 200 continues on to step 204. In step 204, the standard option selected is entered into the annotation field of the cell. If a standard option is not selected, step 203, or following step 204, the process allows entry of text into the annotation field, step 205"* (column 6, lines 40-47). Nolan discloses the generation of an annotation containing the prefilled data, predefined text fields and the user text. Nolan recites *"If the "SHOW DETAIL" selection was made from window 470 of FIG. 3, following the entry of the nursing annotation, a window 486 would be displayed, FIG. 5. Show detail window 486 provides a parameter 487, date 488, time 489, systolic pressure 490, diastolic pressure 491, average pressure 492, date entered 493, time entered 494, entry by 495, and the nurse annotation 496"* (column 5, lines 28-34).

Nolan discloses an annotation system with: the prefilling of data by the system, a user selecting additional fields for data entry, a user adding data to the predefined

text area and the generation of an annotation containing the prefilled data, predefined text fields and the user text. Nolan fails to disclose the use of the annotation system for insurance claims. Borghesi discloses an insurance claim processing system. Borghesi recites "*The present invention provides for a comprehensive method and system for processing insurance claims for use by insurance companies*" (column 2 lines 33-35).

Therefore, it would have been obvious, to one of ordinary skill in the art, at the time the invention was made, to modify the annotations system described by Nolan to manage insurance claims because "*there is a need for a comprehensive system and method of managing an insurance claim work flow wherein all the tasks of processing a claim may be performed and evaluated*" (Borghesi, column2, lines 20-23).

6. **In regard to dependent claim 2**, the claim recites "*The method of claim 1, further comprising the step of storing, in a claim database, the generated file note.*" Nolan anticipates the claim. Nolan recites "*This annotation will then be saved in the data base along with the other data for cell 465*" (column 5, lines 26-27).
7. **In regard to dependent claim 3**, the claim recites "*The method of claim 1, wherein the data is short text, and where the predefined text area includes a table of variables and a corresponding field that receives short text for each variable.*" Nolan anticipates the claim. Nolan recites "*Window 498 provides a list of predefined,*

*commonly used annotations*" (column 5, lines 53-54) and *"the process allows entry of text into the annotation field, step 205"* (column 6, lines 46-47).

8. **In regard to dependent claim 4**, the claim recites *"The method of claim 1, wherein permitting the user to add data further comprises the step of permitting the user to add free form notes in a file note area."* Nolan anticipates the claim. Nolan recites *"Window 480 provides a parameter title 481, date 482, time 483, and a place for the nursing annotation 484"* (column 5, lines 21-22).
9. **In regard to dependent claim 5**, the claim contains substantially the same subject matter as claims 1 and 2 combined, and is rejected with the same rational.
10. **In regard to dependent claim 6**, the claim recites *"The method of claim 1, further comprising the step of obtaining from the user an indication of whether the file note is significant."* Nolan anticipates the claim. Nolan recites *"assigning a first notational designator to said first annotation text"* (column 8, lines 16-17).
11. **In regard to dependent claim 7**, the claim recites *"The method of claim 1, wherein the second set of fields includes a category and a subcategory."* Nolan anticipates the claim. Nolan discloses a category field *"Blood Pressure"* and subcategory fields *"Systolic"* and *Diastolic"* in Figure 5.
12. **In regard to dependent claim 8**, the claim recites *"The method of claim 1, wherein the first set of fields include a suffix field and a participant field, wherein the suffix field indicates the type of insurance coverage, and wherein the participant field*

*indicates a participant to the claim.*" Nolan anticipates the claim. Nolan discloses a suffix field "Vitals" and a series of related fields ("*Heart Rate*", "*Blood Pressure*", "*Temp.*", and "*Respiration Rate*") that each represent a part of the suffix field in Figure 5.

13. **In regard to independent claim 9**, the claim contains substantially the same subject matter as claim 1, and is rejected with the same rational.
14. **In regard to dependent claim 10**, the claim contains substantially the same subject matter as claims 7 and 8 combined, and is rejected with the same rational.
15. **In regard to dependent claim 11**, the claim contains substantially the same subject matter as claim 8, and is rejected with the same rational.
16. **In regard to dependent claim 12**, the claim contains substantially the same subject matter as claim 4, and is rejected with the same rational.
17. **In regard to independent claim 13**, the claim contains substantially the same subject matter as claim 1, and is rejected with the same rational.
18. **In regard to dependent claim 14**, the claim contains substantially the same subject matter as claim 2, and is rejected with the same rational.
19. **In regard to dependent claim 15**, the claim contains substantially the same subject matter as claim 3, and is rejected with the same rational.

20. **In regard to dependent claim 16**, the claim contains substantially the same subject matter as claim 4, and is rejected with the same rational.
21. **In regard to dependent claim 17**, the claim contains substantially the same subject matter as claim 5, and is rejected with the same rational.
22. **In regard to dependent claim 18**, the claim contains substantially the same subject matter as claim 6, and is rejected with the same rational.
23. **In regard to dependent claim 19**, the claim contains substantially the same subject matter as claim 7, and is rejected with the same rational.
24. **In regard to dependent claim 20**, the claim contains substantially the same subject matter as claim 8, and is rejected with the same rational.
25. **In regard to dependent claim 21**, the claim contains substantially the same subject matter as claim 1, and is rejected with the same rational.
26. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- |                  |                     |                 |
|------------------|---------------------|-----------------|
| • Katz et al.    | US Patent 5,404,295 | Filed 1/4/1994  |
| • Tyler et al.   | US Patent 5,523,942 | Filed 3/31/1994 |
| • Rivette et al. | US Patent 5,806,079 | Filed 4/17/1996 |
| • Rivette et al. | US Patent 6,389,434 | Filed 4/9/1998  |




27. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Vaughn whose telephone number is (703) 305-4672. The examiner can normally be reached Monday to Friday from 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R. Herndon can be reached at (703) 308-5186. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Gregory J. Vaughn  
September 30, 2003



SANJIV SHAH  
PRIMARY EXAMINER  
HKS ALIANS